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DEC 13 2006

**OFFICE OF PETITIONS**

In re Application of :  
Michael Tombs, et. al. :  
Application No. 10/044,798 : ON PETITION  
Filed: January 10, 2002 :  
Attorney Docket No. 211/New :  
:

This is a decision on the petition under 37 CFR 1.137(a), filed August 1, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed;<sup>1</sup> (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks items (1) and (2).

The application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months from the date of the

<sup>1</sup> In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

decision mailed November 14, 2005, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned after midnight on January 14, 2006. See MPEP 1215.04.

In the instant petition, petitioner argues that he was not aware of the advisory action and that a search of the file and his office was conducted, but the advisory action was not found or docketed. Accordingly, petitioner states that it is clear that the advisory action was never received and, therefore, the delay in timely filing a reply was unavoidable.

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

It is irrelevant here whether or not petitioner received an advisory action. Rather, petitioner must demonstrate why an appeal brief (or an appropriate reply to maintain pendency of this application) was not timely filed within the two month extendable period set in the decision mailed November 14, 2005. The Notice of Abandonment mailed on June 27, 2006 states that this application became abandoned for failure to timely reply to the Office letter dated November 14, 2005, and makes no mention of an advisory action.

Further, petitioner is reminded that he may not rely upon non-receipt of an advisory action to establish that the delay was unavoidable. 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid

abandonment of the application in the absence of a timely and proper appeal. A delay is not "unavoidable" when an applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. See MPEP 711.03(c)(II).

In view of the above, the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). See MPEP 711(c)(II)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

If petitioner cannot provide the evidence required to establish under the 37 CFR 1.137(a) that the delay in providing the required reply to the decision mailed on November 14, 2005 was unavoidable, or simply does not wish to, petitioner should consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$1,500 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further, petitioner should note that the proposed reply required for consideration of a petition to revive must be an appeal brief under 37 CFR 41.37 and the appeal brief fee required by 37 CFR 41.20(b)(2), a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). A courtesy copy of the advisory action mailed November 22, 2005, is enclosed for petitioner's records. Additionally, the amendment filed on August 1, 2006 again fails to place the application in condition for allowance; consequently, petitioner must submit the reply to continue prosecution of this application. See final advisory action attached to this decision.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: **Mail Stop PETITION**  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

By Facsimile: **(571) 273-8300**  
Attn: Office of Petitions

By Hand: U. S. Patent and Trademark Office  
Customer Service Window, Mail Stop Petitions  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries concerning this decision should be directed to Andrea Smith at (571) 272-3226.



Frances Hicks  
Lead Petitions Examiner  
Office of Petitions

Enclosure: Courtesy copy of the advisory action mailed November 22, 2005.  
Final advisory action in response to amendment filed August 1, 2006.

<b>Advisory Action Before the Filing of an Appeal Brief</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/044,798	TOMBS ET AL.	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2.  The Notice of Appeal was filed on 26 September 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a)  They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b)  They raise the issue of new matter (see NOTE below);  
 (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d)  They present additional claims without canceling a corresponding number of finally rejected claims..

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 25-28 and 32-35.

Claim(s) objected to: 13,15,18,19,23,24 and 31.

Claim(s) rejected: 8-12,14,16,17,20-22,29 and 30.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
 \_\_\_\_\_  
 12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13.  Other: Notice of Non-Compliant Amdt under 37 CFR 1.121 is attached.

## Continuation of 3. NOTE:

Newly amended claim 9 presents new issues which would require additional considerations under 35 USC 112, second paragraph since it is unclear how the means for lowering the solder surface set forth at lines 7-8 relates to means at line 11-12 which also claims the recited means function to lower solder surface (duplicate claim language ?).

Newly amended claim 25 presents new issues which would require additional considerations under 35 USC 112, second paragraph since it is unclear how the means for lowering the solder surface set forth at lines 6-7 relates to means at line 8-9 which also claims the recited means function to lower solder surface (duplicate claim language ?).

Newly amended claim 32 presents new issues which would require additional considerations under 35 USC 112, second paragraph since it is unclear how the means for lowering the solder surface set forth at lines 8-9 relates to means at line 9-10 which also claims the recited means function to lower solder surface (duplicate claim language ?)

Newly amended claim 14 presents a new issue which would require additional considerations under 35 USC 112, second paragraph since it is unclear what an "upward/y facing edge" encompasses.

It is noted that applicant in the instant amendment has multiple duplicate claims which would require additional considerations under 37 CFR 1.75 and some examples of the duplicate claims are discussed below.

Dependent claim 19 which has been amended to depend on claim 9 presents a new issue which would require additional considerations under 37 CFR 1.75 as being a duplicate of claim 15 which also depends on claim 9 with both claim 19 and claim 15 claiming the member has a honeycomb structure.

Newly amended claim 29 presents a new issue which would require additional considerations under 37 CFR 1.75 as being a duplicate of claim 33.

Newly amended claim 20 presents a new issue which would require additional considerations under 37 CFR 1.75 as being a duplicate of claim 27.

Newly amended claim 9 presents a new issue which would require additional considerations under 37 CFR 1.75 as being a duplicate of claim 28.

It is noted that claims 8,14,19,20,25,29 and 32 have been currently amended yet have not been provided with the proper status identifier as is required under 37 CFR 1.121 and the insertion of claim language in claims 8,14,19,20,25,29 and 32 have not underlined as required under 37 CFR 1.121. It is noted that claim 9 has inserted claim language without underlining as required under 37 CFR 1.121 (see lines 7-8 of claim 9).

Brenda Adele Lamb  
Primary Examiner  
AU 1734



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,798	01/10/2002	Michael Tombs	211/New	8385
22440	7590	11/22/2005	EXAMINER	
GOTTLIEB RACKMAN & REISMAN PC			LAMB, BRENDA A	
270 MADISON AVENUE			ART UNIT	PAPER NUMBER
8TH FLOOR			1734	
NEW YORK, NY 100160601				

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action Before the Filing of an Appeal Brief</b>	<b>Application No.</b> <b>10/044,798</b>	<b>Applicant(s)</b> <b>TOMBS ET AL.</b>
	<b>Examiner</b> <b>Brenda A. Lamb</b>	<b>Art Unit</b> <b>1734</b>
	<b>--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</b>	
<b>THE REPLY FILED <u>9/26/05</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.</b>		
<p>1. <input type="checkbox"/> The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:</p> <p>a) <input type="checkbox"/> The period for reply expires _____ months from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p>		
<p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>		
<p><b>NOTICE OF APPEAL</b></p> <p>2. <input checked="" type="checkbox"/> The Notice of Appeal was filed on <u>26 September 2005</u>. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).</p>		
<p><b>AMENDMENTS</b></p> <p>3. <input checked="" type="checkbox"/> The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because</p> <p>(a) <input checked="" type="checkbox"/> They raise new issues that would require further consideration and/or search (see NOTE below);</p> <p>(b) <input type="checkbox"/> They raise the issue of new matter (see NOTE below);</p> <p>(c) <input checked="" type="checkbox"/> They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p> <p>(d) <input type="checkbox"/> They present additional claims without canceling a corresponding number of finally rejected claims.</p> <p>NOTE: <u>See Continuation Sheet</u>. (See 37 CFR 1.116 and 41.33(a)).</p>		
<p>4. <input type="checkbox"/> The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).</p> <p>5. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____.</p> <p>6. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p>		
<p>7. <input checked="" type="checkbox"/> For purposes of appeal, the proposed amendment(s): a) <input checked="" type="checkbox"/> will not be entered, or b) <input type="checkbox"/> will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.</p> <p>The status of the claim(s) is (or will be) as follows:</p> <p>Claim(s) allowed: <u>25-28 and 32-35</u>.</p> <p>Claim(s) objected to: <u>13, 15, 18, 19, 23, 24 and 31</u>.</p> <p>Claim(s) rejected: <u>8-12, 14, 16, 17, 20-22, 29 and 30</u>.</p> <p>Claim(s) withdrawn from consideration: _____.</p>		
<p><b>AFFIDAVIT OR OTHER EVIDENCE</b></p> <p>8. <input type="checkbox"/> The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).</p> <p>9. <input type="checkbox"/> The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).</p> <p>10. <input type="checkbox"/> The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.</p>		
<p><b>REQUEST FOR RECONSIDERATION/OTHER</b></p> <p>11. <input type="checkbox"/> The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.</p> <p>12. <input type="checkbox"/> Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.</p> <p>13. <input type="checkbox"/> Other: _____.</p>		

Continuation of 3. NOTE: The amendment filed 9/26/2005 has multiple duplicate claims which presents new issues which would require additional considerations under 37 CFR 1.75 and some examples of the duplicate claims are discussed below.

Newly amended claim 29 presents new issues which would require additional considerations in that claim 29 appears to be now a duplicate of claim 33 and therefore newly amended 29 is objected under 37 CFR 1.75. Newly amended claim 16 presents new issues which would require additional considerations under 37 CFR 1.75 in that claim 16 is a substantial duplicate of claim 29 since the functional recitation that the leads to be soldered are selectively removed between a raised and lowered position fails to structurally further limit and distinguish one apparatus claim from the other. The examiner also notes that claim 28 appears to be a substantial duplicate of newly amended claim 9, claim 11 which depends on newly amended claim 9 appears to be a substantial duplicate of claim 22, dependent claim 17 which depends on newly amended claim 18 appears to be a substantial duplicate of claim 34 and newly amended claim 15 appears a substantial duplicate of claim 35 since the functional recitation that the leads to be soldered are selectively removable between a raised and lowered position fails to structurally further limit and distinguish one apparatus claim from the other thereby requiring additional considerations under 37 CFR 1.75. It is suggested that applicant review claims for duplication of limitations in responding the instant advisory action in order to avoid objections of the claims under 37 CFR 1.75.

Claim 20 presents a new issue under 35 USC 112, second paragraph since claim 20 is improper since the claim ends with a semicolon and unclear whether applicant intended to present additional limitations in claim 20

*Brenda A. Lamb*  
BRENDA A. LAMB  
PRIMARY EXAMINER